REMARKS

In this response, claims 1, 10-11, 19, 23-26, and 28-30 have been amended. Claims 31-55 have been added and no claims have been canceled. Accordingly, claims 1-55 remain pending in the present application. Reconsideration of the above-identified patent application is hereby requested.

Rejection Under 35 U.S.C. § 101

The Examiner has rejected claims 1-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner has rejected the claims because they are directed to nonfunctional descriptive material and are not statutory. The Examiner asserts that "Applicant merely describes a tool that lists one or more entities and a measure of frequency [which] is a mere compilation of data but does not create any functional interrelationship between the stored data nor the computer process performed by the computer." Applicant respectfully traverses this statutory subject matter rejection and reconsideration and withdrawal of the rejection is respectfully requested.

35 U.S.C. § 101 provides that "Whoever invents or discovers any new and useful process . . . or any new and useful improvement thereof may obtain a patent therefore, subject to the conditions and requirements of this title." Further, a statutory

"process" encompasses "[a] process, art or method . . . ." 35 U.S.C. § 100(b).

Applicant submit that the quality rating tool as claimed by Applicant does include a functional interrelationship between the stored data and the computer process performed by the computer because the claimed quality rating tools include various measures that is the result of the functioning of the computer process. For example, claim 1 includes the limitation that the quality rating tool comprises "a measure indicating the frequency with which a level of dosing of a medication was prescribed by an entity in the plurality of entities." Thus, Applicant submits that the functional interrelationship is created by the inclusion of the frequency limitation, where the frequency is a summary of the stored data tracking the number of times where a level of dosing of a medication was prescribed by an entity. The computer process determines the frequency by its operation on that data. The other independent claims include limitations that also meet the same functional interrelationship requirement (e.g., claim 10 includes a "measure indicating the frequency with which use of an antibiotic for treating a condition is prescribed by an entity in the plurality of entities"; claim 19 includes a "measure indicating the frequency with which appropriate diagnostic testing was performed when prescribing antibiotics for a condition"; claim 23 includes a "measure indicating the cost of health services and products incurred by a health care consumer

obtaining health care services from an entity in the plurality of entities"; claim 26 includes measures for "a safe dosing of a medication", "a use of preferred antibiotics", and "an overuse of antibiotics"; and, claim 27 includes measures for "a member pharmaceutical cost", and "a member emergency services cost."

Applicant respectfully notes that the rejection asserted by the Examiner does not apply to claims 28-30, which are method claims clearly directed to statutory subject matter. Specifically, Applicant has indisputably included limitations directed to a concrete, tangible, and useful application, which is the creation of a quality rating tool for use in selection of health care services providers by health care services consumers.

Applicant further notes that Applicant has added claims 31-55, which recite an article of manufacture having a program storage medium having computer readable program code embodied therein to create the various claimed quality rating tools. While Applicant has added claims 31-55 to introduce claims with additional limitations to more specifically claim the invention to which the Specification is directed, Federal Circuit precedent makes clear that physical limitations, such as computer hardware or a computer readable medium, are not required for claims to be statutory. A recent affirmation of this proposition is provided by the Federal Circuit in the case of AT&T Corp. v. Excel Communications, 172 F.3d 1352, 1357 (Fed. Cir. 1999). In AT&T, the claims at issue were directed to a telecommunications method

utilizing a message record for long-distance telephone calls which was enhanced by the addition of a primary interexchange carrier ("PIC") indicator. Id. at 1353. The claims were directed only to a message record--i.e., a data structure--and did not require any hardware limitations. Id. at 1354. Nevertheless, the Federal Circuit found that "[t]he PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long distance calls . . . ." Id. at 1358. As a result, the Court held that "all the claims fall comfortably within the broad scope of patentable subject matter under § 101." Id. at 1361. The Court specifically rejected the contention of the defendant in the case that the asserted claims were unpatentable because they lacked physical limitations, holding that "this type of physical limitations analysis seems of little value." Id. at 1359.

Applicant has indisputably included limitations directed to a concrete, tangible, and useful application, which is a quality rating tool (and the creation thereof) for use in selection of health care services providers by health care services consumers. Thus, the recitation of computer hardware or network limitations or a computer readable medium in Applicant's claim is not necessary to satisfy 35 U.S.C. § 101.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-30 under 35 U.S.C. § 103 as being unpatentable over Lockwood (U.S. Pat. No. 5,706,441) in view of Pack-Harris (U.S. Pat. No. 6,195,612). Specifically, the Examiner asserts that the teachings of Pack-Harris, when combined with Lockwood, renders claims 1-30 obvious. Applicant respectfully traverses the Examiner's § 103 rejections.

For example, with respect to claim 1, the Examiner asserts "Lockwood teaches a quality rating tool wherein the quality rating tool is used to select an entity for providing health care services to a health care consumer (Lockwood; Abstract) [and] [i]t would have been obvious to add the prescription utilization feature of Pack-Harris to the Lockwood quality-rating tool with the motivation of providing information regarding the drugs obtained and their actual costs (Pack-Harris; Col. 2, lines 18-22)." 03-13-06 Action, Para. 16.

Applicant respectfully submits that Lockwood does not teach a quality rating tool that "is used to select an entity for providing health care services to a health care consumer" as asserted by the Examiner. Lockwood provides "[a] method and apparatus for objectively assessing the complexity of health-care services delivered by each health-care provider within a group of health-care providers . . . ." Lockwood, Abstract, lines 1-4. Importantly, Applicant notes that Lockwood teaches that the method and apparatus is used by health-care networks "to fully

and appropriately" compensate each hospital (i.e., health-care provider) for all health-care services delivered by the health-care provider "in order to maintain the quality of services and expertise at these hospitals." Lockwood, Col. 3, lines 18-21. Thus, as Lockwood is used by health-care networks to more efficiently oversee the operation of the health-care network, Lockwood actually teaches away from the use of the method and apparatus as a quality rating tool for the selection of a health care provider by a health care consumer. Specifically, Lockwood teaches that it is the network (e.g., an administrator of the network) that uses this tool for running the network more efficiently, which is different than providing better care for consumers and may even lead to adverse results from a network inadvertently "cutting corners" to save costs.

Further, Pack-Harris suffers from a similar deficiency in terms of its applicability as a quality rating tool for assisting a health care consumer in the selection of a health care provider in that Pack-Harris describes a system to be used by medical groups for managing prescription drug activity of the medical groups and thereby tracking costs. Pack-Harris, Col. 2, lines 25-56. The ability to manage these costs directly impact the profitability of the medical groups. Pack-Harris, Col. 1, lines 45-59. Thus, Pack-Harris does not teach or suggest the creation of a quality rating tool, either alone or in combination with Lockwood. At best, the combination of Pack-Harris with

Lockwood would create a system that assists medical service providers (e.g., medical groups) in saving costs and enhancing their "bottom line," which does not necessarily translate to being a tool to be used by health care consumers to choose providers for medical services.

Applicant notes that independent claims 1, 10, 19, 23, and 26-30 contain the quality rating limitation described by Applicant with regards to the 35 U.S.C. § 103 rejection. Dependant claims 2-9, 11-18, 20-22, and 24-25, by virtue of depending on these independent claims, also contain the same limitation. Further, newly added claims 31-55 also include the quality rating limitation. As neither Lockwood or Pack-Harris, alone or in combination, teaches or suggests this limitation, Applicant submits that these claims are allowable for the same reasons as discussed above.

In view of the foregoing discussion, Applicant submits that the § 103 rejections are overcome. Thus, Applicant respectfully requests that the § 103 rejections be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If any additional fees apply, please charge our Deposit Account No. 10-0440.

Respectfully submitted,

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